



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/501,944

07/21/2004

Mikka Poikselka

47092.00096

8466

32294

7590

06/27/2008

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

MCADAMS, BRAD

ART UNIT

PAPER NUMBER

2152

MAIL DATE

DELIVERY MODE

06/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/501,944	Applicant(s) POIKSELKA ET AL.	
	Examiner ROBERT MCADAMS	Art Unit 4134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/10/2006, 08/17/2006, 07/21/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-36** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,859,649 B1 by *Denenberg et al (Denenberg)*.

3. As to **Claims 1 - 4**, *Denenberg* discloses detecting a change in said subscription information of said subscriber (During the registration process, changes in subscription information to new services are detected. Column 4, Lines 35-42);

Checking whether a capability of a network element serving a terminal device of said subscriber is still in accordance with said changed subscription information (During the registration process, the subscription information is checked against the network element. Column 5, Lines 3-6); and

Initiating in response to the result of said checking step a registration procedure for registering said terminal device of said subscriber to a new serving network element (In response to checking capability, the terminal device is registered to the new network element. Column 5, Lines 7-9).

As to **Claims 5 - 7**, *Denenberg* further discloses wherein said checking step is performed on the basis of a capability information added based on said detection step to a response message of a re-registration procedure initiated by said terminal device (In the event of subscriber information incompatibility, said terminal device is de-registered and given alternate capability information for re-registration during the activation periods. Column 5, Lines 23-42)

As to **Claims 8 and 19-20**, *Denenberg* further discloses wherein a configuration information is provided for determining subscribed services needing predetermined serving network elements (Administrative Center 280 provides configuration information for terminal devices and network elements, predetermining which network elements are subscribable. Column 5, Lines 43-62).

As to **Claims 9-18**, *Denenberg* further discloses wherein said checking step comprises the steps of transmitting a capability query comprising an information indicating at least one required capability to said serving network element (The subscriber provides a required capability (home location)),

Comparing capabilities of said serving network element with said information about said at least one required capabilities (The required capability is compared with eligibility database by the interrogator), and

Receiving an acknowledgment indicating the result of said comparing step from said serving network element (An acknowledgment is received from the comparing step. If said elements are compatible then subscriber is passed through the proxy network

element to be registered, else the subscriber is de-registered and given an alternative selection of compatible network elements for re-registration.) (Column 5, Lines 10-43).

System **Claims 21-31** and Database **Claims 32-36** correspond to method **Claims 1-20** and are therefore analyzed and rejected the same as previously discussed with respect to **Claims 1-20**.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MCADAMS whose telephone number is (571)270-3309. The examiner can normally be reached on Monday-Thursday 6:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lun-Yi Lao can be reached on 571-272-7671. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT MCADAMS/
Examiner, Art Unit 4134

/LUN-YI LAO/
Supervisory Patent Examiner, Art Unit 4134